

REMARKS

Restriction is required between:

- I. Claims 1-22, drawn to a catalyst composition, classified in Class 502, subclass 305+
- II. Claims 23-64, drawn to a process of preparing a catalyst composition, classified in Class 502, subclass 104+
- III. Claims 65-89, drawn to a process for producing an unsaturated carboxylic acid from an alkane, etc., using a catalyst composition, classified in Class 562, subclass 547+

The applicants provisionally elect Group I, Claims 1-22, with traverse.

The Examiner has required restriction under 35 USC §121 on the basis that each group is distinct. It is stated in 35 USC §121 that restriction may be required when "two or more independent and distinct inventions are claimed in one application" (emphasis added). Even assuming that the groups of claims of the present invention are distinct, the Examiner has not shown how they are independent. For this reason alone, i.e., failure to meet a statutory prerequisite, the restriction requirement should be withdrawn. While the applicants are aware that MPEP§803 allows restriction when there are either independent or distinct inventions, the Manual of Patent Examining Procedure is not law and the examiner has not cited statutory or case law authority which supports interpretation of the conjunctive language, i.e., "independent and distinct", as being alternative, i.e., "independent or distinct".

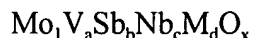
The examiner's restriction requirement states that the inventions of Groups I, II and III are distinct. MPEP §802 defines distinct as follows:

“DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). . . .”

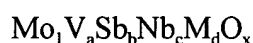
The applicants submit that the Examiner has not shown the claims of Group I, Group II, Group III and Group IV to be distinct in accordance with the above definition. The claims of Group I are drawn to a catalyst composition, the claims of Group II are drawn to a process of preparing the catalyst composition of Group I and the claims of Group III are drawn to a process for producing an unsaturated carboxylic acid from an alkane, etc., using the catalyst composition of Group I. Groups I, II and III are related since all of the groups are for a catalyst composition, a process of preparing the catalyst composition and a process for producing an unsaturated carboxylic acid from an alkane, etc., using the catalyst composition.

The examiner argues that Group I and Group II are related as process of making and product made but are distinct because the process as claimed can be used to make another and materially different product, such as ceramic materials or refractory metal oxide support materials containing metal oxides. Claim 23 of Group II is for "[a] process of making a catalyst composition for production of an unsaturated carboxylic acid from an alkane ... to form a catalyst of the formula:



wherein Mo is molybdenum, V is vanadium, Sb is antimony, Nb is niobium, M is gallium, silver or gold, O is oxygen, a is from 0.01 to 1, b is 0.01 to 1, c is 0.01 to 1, d is 0.01 to 1 and x is determined by the valence requirements of the other elements present". The examiner has not shown how the process as claimed can be used to make another and materially different product.

The examiner argues that Group I and Group III are related as product and process of use but are distinct because the product can be used in a materially different process of using, such as purification of automotive exhaust gases from an internal combustion engine. Claim 1 of Group I is for "[a] catalyst composition for production of an unsaturated carboxylic acid from an alkane comprising a compound of the formula:



wherein Mo is molybdenum, V is vanadium, Sb is antimony, Nb is niobium, M is gallium, bismuth, silver or gold, a is from 0.01 to 1, b is 0.01 to 1, c is 0.01 to 1, d is 0.01 to 1, and x is determined by the valence requirements of the other elements present". The examiner has not shown how the product as claimed can be used in a materially different process.

The examiner argues that Group II and Group III are unrelated and cites MPEP§§802.01 and 806.06 which state that inventions may be independent if there is "no disclosed relationship" and may be distinct if "the inventions *as claimed* (emphasis in original) are not connected in at least one of design, operation or effect". The examiner has not taken into consideration that Group II, as claimed, is for a process for preparing a particular catalyst composition and that Group III, as claimed, is for a process for producing unsaturated carboxylic acid from an alkane, etc., using the same particular catalyst composition in her determination that there is no disclosed relationship and that the inventions are not connected in at least one of design, operation or effect.

The examiner has not shown that related Groups I and II and related Groups I and III are distinct. The examiner has not shown that Groups II and III are unrelated or, if unrelated, are independent and distinct. Therefore, the applicants request that the restriction requirement be withdrawn.

The examiner argues that different searches are required for Group I, Group II and Group III. As noted by MPEP § 803:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).”


Even if the inventions of Group I, Group II and Group III are independent and distinct, the applicants submit that for the reasons below examination of the claims of Group I, Group II and Group III does not present a serious burden on the Examiner. The asserted utility of Group I is for a catalyst composition, the asserted utility of Group II is for a process for preparing the catalyst composition and the asserted utility of Group III is for a process for producing an unsaturated carboxylic acid from an alkane, etc., using the catalyst composition. The search for each group must include the particular catalyst composition. This being the case, it would appear that the field of search for the subject matter of any one of the groups would include the field of

search for all of the other groups. Since the fields of search for the groups of claims would appear to be largely co-extensive, examination of the inventions, even assuming that they are directed to patentably distinct inventions, would best serve the interest of the Patent and Trademark Office, the public and the present applicants. Accordingly, the applicants respectfully requests that the restriction requirement be withdrawn.

The applicants believe that no extension of term is required. However, this conditional petition is being made to provide for the possibility that the applicants have inadvertently overlooked the need for a petition and fee for extension of time. If an additional extension of time is required, please consider this a petition therefor. The Commissioner is hereby authorized to charge any additional fees due by filing this paper or to credit any overpayment to Account No.502025.

On the basis of the above amendments and remarks, reconsideration of this application is requested and its allowance requested at the examiner's earliest convenience. No new matter has been added.

Respectfully submitted,



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